

REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Amendments to Claims

Claim 1 has been amended to emphasize that (i) the network card of the invention is arranged to be inserted into a card-insertion slot of the first computing device, (ii) both the first and second computing devices transmit action signals to the card through the respective interfaces, and (iii) the action signals are detected, judged, and supported in order to carry out application demands from both the first and second computing devices.

All of these features were recited in the original claims, but it appears that the Examiner has not understood them since the prior art applied does not *disclose* cards arranged to be inserted into slots in a first computing device, or cards arranged to receive action signals that support application demands from both computing devices to which the card may be connected (as opposed to simply transmitting signals between a computer and a printer or other peripheral device that does not make application demands).

2. Rejection of Claims 1-5 in view of Applicant's U.S. Patent No. 6,567,273

This rejection is respectfully traversed on the grounds that the claims of the '273 patent do not recite a communication network card that can

- “detect, judge, and support action signals” received from different computing devices through interfaces at opposite ends of the card, as recited in claim 1 of the present application.

To the contrary, the '273 patent claims a silicon disk (memory) card with a USB plug that merely

- “*discriminat[es] which interface is accessing said data*” and
- enables “*access to said flash memory*.”

It is respectfully submitted that discriminating which interface is accessing the data, and “enabling access to a flash memory,” is not the same as “*detecting, judging, and supporting action signals*” as claimed.

In reply, the Examiner argues that the ‘273 **discloses** a bridging chip that detects insertion of a USB plug. While the ‘273 patent might **disclose** detection of a USB plug, however, it does not **claim** such detection. Therefore, the **double patenting** rejection is clearly improper. **THE SPECIFICATION OF THE ‘273 PATENT IS NOT PRIOR ART AGAINST THE PRESENT APPLICATION.** The purpose of the double patenting is to prevent extension of the patent monopoly by **CLAIMING** the same invention or obvious variants thereof.

Furthermore, the ‘273 patent does not even disclose “judging” and “supporting” the signals by ordering components on the circuit board to perform the requested actions. The “bridging chip” of the ‘273 card is simply a discriminator, and the card is a passive memory device that lacks the full functionality of the claimed micro control chip. The Examiner’s conclusion that “it was obvious that the levels of detect, control or judge and support action signal (or interface) is a design choice of the software of the bridging chip” is not supported by any teachings in the reference, but is clearly the result of the Examiner’s desire to reject the claims of the application, *i.e.*, the hindsight knowledge that resulted from the Examiner’s reading of the Applicant’s own claims.

Because the commonly assigned Liu patent is not prior art against the claims of the present application, does not claim the present invention, and does not even include disclosure suggesting the present invention, withdrawal of the double patenting rejection is respectfully requested.

3. Rejection of Claims 1, 2, 4, and 5 Under 35 USC §102(e) in view of U.S. Patent No. 6,694,376 (Ohara)

This rejection is again respectfully traversed on the grounds that the Ohara patent fails to disclose or suggest a storage communication network card in which a first end is arranged to be *inserted* into a *card insert slot* of a *first* computing device, and the second end is arranged to be connected to a second computing device, the card including a micro control chip that detects, judges and executes commands supplied through *either* interface at either end, so that the card can either be connected in conventional fashion by inserting it into the PC card slot, or the card can be connected through a cabled or bluetooth interface without the need for the host to include a PC card slot or corresponding adapter.

The basis for the continued rejection is apparently that a printer can be called a “computing device.” While it is certainly possible to call a printer a computing device, however, the printer of Ohara does not correspond to the claimed second computing device because it does not send action signals to the NIC/Modem to support application demands on the modem, as claimed. Instead, the modem of Ohara merely passes data through to the first computing device.

Furthermore, the Examiner has not even addressed the fact that Ohara’s card is not designed to be inserted into a card slot, as claimed. To the contrary, the Network Interface Controller (NIC) of Ohara is clearly not inserted into an interface slot of the host computer G, but rather communicates with the host computer through transceiver 2 via the network W. This difference alone should clearly preclude a rejection under 35 USC §102(e).

In summary, the Ohara patent fails to disclose or suggest a card of the type that can be inserted into a card slot, and that is further capable of being connected at opposite ends to different host computing devices with different types of interfaces, *i.e.*, a single peripheral that supports *two* hosts and can be controlled by *either*. Instead, the Ohara patent is directed to a controller that serves as a network interface between a host computer and a printer connected to the network. As a result, it is respectfully submitted that the Ohara patent neither discloses nor

suggests the claimed invention, and withdrawal of the rejection of claims 1, 2, 4, and 5 based on the Ohara patent is respectfully requested.

4. Rejection of Claim 3 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,694,376 (Ohara) and 6,560,099 (Chang)

This rejection is again respectfully traversed on the grounds that the Chang patent, like the Ohara patent, fails to disclose or suggest a dual-interface communication network card that includes a micro control chip arranged to execute commands supplied through *either* interface at either end, so that the card can either be connected in conventional fashion by **inserting** it into a **PC card slot**, or the card can be connected through a cabled or bluetooth interface without the need for the host to include a PC card slot or corresponding adapter.

The Chang patent discloses an interface card with two conventional IDE interfaces and two conventional USB interfaces, and a cut-over switches that allows either of the IDE interfaces to be connected to either of the USB interfaces. There is no suggestion of a micro control chip for detecting, judging, and supporting action signals received from either end, as claimed, much less configuration of the first interface to be inserted into an insert slot, as claimed. Furthermore, the interface card of Chang has nothing to do with the network printer interface controller of Ohara, and there is no possible reason, except the suggestions of Applicant's own disclosure (*i.e.*, hindsight), to combine the teachings of Ohara and Chang. As a result, it is respectfully submitted that the rejection of claim 3 under 35 USC §103 in view of the Ohara and Chang patents is improper, and withdrawal of the rejection is respectfully requested.

5. Rejection of Claims 1, 2, 4, and 5 Under 35 USC §102(e) in view of U.S. Patent No. 5,857,087 (Bemanian)

This rejection is respectfully traversed on the grounds that the Bemanian patent, like the Ohara patent, fails to disclose or suggest a storage communication network card in which a first end is arranged to be inserted into a card insert slot of a first computing device, and the second end is arranged to be connected to a second computing device, the card including a micro control chip that detects, judges and executes commands supplied through *either* interface at either end,

so that the card can either be connected in conventional fashion by inserting it into the PC card slot, or the card can be connected through a cabled or bluetooth interface without the need for the host to include a PC card slot or corresponding adapter.

Instead, like the controller of Ohara, discussed above, the device of Bemanian is neither a network communication card designed to be inserted into the slot of a computer (such a PCMCIA card), and clearly bears no resemblance to the peripheral products recited in claim 5. Furthermore, the interface and CPU module of Bemanian merely converts and transmits data between the respective interfaces, and does not order a circuit board or other electronic components in the card to support instructional actions resulting from application demands in respective first and second computing devices, as claimed.

According to the Examiner, modification of the modem of Bemanian to fit into a card slot, and to handle application demands from two computing devices, *i.e.*, the novel features of the invention, are all design choices. This conclusory reasoning is improper for at least two reasons. First, the rejection is under 35 USC §102(e) which requires disclosure (anticipation) of the features of the invention. Second, there is absolutely no suggestion in the Bemanian patent of any of the necessary modifications.

The Examiner is reminded that, as pointed out in, for example, *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so [quoting ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929,933 (Fed. Cir. 1984)].' Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In addition, *In re Gorman*, 18 USPQ 2d 1886, 1888 (Fed. Cir. 1990) points out that it is improper:

...simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps [citing *Interconnect Planning Corporation v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985)].

It is respectfully submitted that modification of the card of Bemanian to fit into a card slot of a computing device, as claimed, and to include the capability of detecting, judging, and supporting action signals in the manner claimed requires precisely the type of hindsight reconstruction of the claimed invention referred to in the *Fritch* and *Gorman* cases. Even if it were possible to program the interface module of Bemanian to carry out the claimed functions, there is no teaching or suggestion to do so, and therefore the claimed invention is patentable under both 35 USC §102(e) and 35 USC §103(a).

Basically, the CPU module 36 pf Bemanian merely transfers data between a P-bus interface module and network interface modules on separate processor boards. This does not correspond to the network communication card of the claimed invention. All of the "modules" of Bemanian are on separate cards and there is no suggestion of housing them all within a PC card. In fact, the network interface modules are connected to the CPU module by bus 84. Neither the P-bus interface nor the network interface modules of Bemanian have interfaces at either end, in the claimed manner. As a result, it is respectfully submitted that the Bemanian patent, which is directed to distributed communications modules and not to a double interface communications card of the type claimed, does not anticipate any of claims 1, 2, 4, and 5, and withdrawal of the rejection under 35 USC §102(e) in view of the Bemanian patent is respectfully requested.

6. Rejection of Claim 3 Under 35 USC §103(a) in view of U.S. Patent Nos. 5,857,087 (Bemanian) and 6,560,099 (Chang)

This rejection is respectfully traversed on the grounds that the Chang patent, like the Bemanian patent and as discussed above, fails to disclose or suggest a dual-interface communication network card that includes a micro control chip arranged to execute commands

supplied through *either* interface at either end, so that the card can either be connected in conventional fashion by inserting it into the PC card slot, or the card can be connected through a cabled or bluetooth interface without the need for the host to include a PC card slot or corresponding adapter. Instead, as noted above, the Chang patent discloses an interface card with two conventional IDE interfaces and two conventional USB interfaces, and a cut-over switches that allows either of the IDE interfaces to be connected to either of the USB interfaces. As a result, it is respectfully submitted that the rejection of claim 3 under 35 USC §103 in view of the Bemanian and Chang patents is improper, and withdrawal of the rejection of claim 3 under 35 USC §103(a) is respectfully requested.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

BACON & THOMAS, PLLC



By: BENJAMIN E. URCIA
Registration No. 33,805

Date: February 1, 2005

BACON & THOMAS, PLLC
625 Slaters Lane, 4th Floor
Alexandria, Virginia 22314

Telephone: (703) 683-0500